

**REMARKS**

Favorable reconsideration of this application, in light of the present amendment and the following discussion, is respectfully requested.

Claims 39-93 remain pending in this application, claims 44-47 and 52-93 having been withdrawn from consideration by the Examiner as being drawn to a non-elected invention, and claims 39-43 and 48-51 having been amended, by the present amendment.

In the outstanding Office Action, the restriction and election of species requirement made in the Office Action mailed on August 27, 2002 was made Final, it was alleged that the Information Disclosure Statement failed to comply with 37 C.F.R. § 1.98(a)(3) and therefore was placed of record in the application file, but information listed therein was not considered, the title of the invention was found not to be descriptive, claims 39, 42, 48, and 49 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite, claims 39-42 and 48-51 were rejected under 35 U.S.C. § 102(e) as being anticipated by *Canto*, and claim 43 was rejected under 35 U.S.C. § 103(a) as being unpatentable over *Canto* in view of *Imazaike et al.*

The Office Action alleges that the Information Disclosure Statement filed on August 9, 2002 fails to comply with 37 C.F.R. § 1.98(a)(3) because “it does not include a concise explanation of the relevance, as it is presently understood by the individual designated in 37 C.F.R. § 1.56 most knowledgeable about the content of the information, of each patent listed that is not in the English language.” Applicants respectfully submit that the last three listed references (i.e., references listed as AT through AV on the List of References Cited by Application or PTO-Form 1449) do indeed have a statement of relevance since all three references were discussed in the Background Art section of the specification (i.e., the AT reference or Japanese Patent Application Publication No. 9-262262 being discussed on pages 1 and 10 of the specification, the AU reference or Japanese Patent Application Publication

No. 6-190012 being discussed on pages 3, 8, and 12 of the specification, and the AV reference or Japanese Patent Application Publication No. 2511451 being discussed on page 8 of the specification) and also had a English abstract attached thereto, either the discussion of the reference in the specification or the English abstract serving as the statement of relevance.

Further, the references AK through AS of the Information Disclosure Statement filed on August 9, 2001 were all references listed from an International Search Report and a copy of the International Search Report in English was filed with the Information Disclosure Statement filed on August 9, 2001. The Manual of Patent Examining Procedure (hereinafter MPEP), section 1893.03(g), entitled Information Disclosure Statement in a National Stage Application, states, as follows:

An extensive discussion of Information Disclosure Statement practice is to be found in MPEP § 609. Although not specifically stated therein, the duty to disclose information material to patentability as defined in 37 CFR 1.56 is placed on individuals associated with the filing and prosecution of a national stage application in the same manner as for a domestic national application. The declaration requires the same averments with respect to the duty under 37 CFR 1.56.

When an international application is filed under the Patent Cooperation Treaty (PCT), prior art documents may be cited by the examiner in the international search report and/or the international preliminary examination report. When a national stage application is filed under 35 U.S.C. 371, or a national application is filed under 35 U.S.C. 111 claiming benefit of the filing date of the international application, it is often desirable to have the examiner consider the documents cited in the international application when examining the national application.

As a result of an agreement among the European Patent Office (EPO), Japanese Patent Office (JPO), and the United States Patent and Trademark Office (USPTO), copies of documents cited in the international search report issued by any one of these International Searching Authority Offices generally are being sent to the other Offices when designated in the international application. Accordingly, in many national stage applications where the international search was conducted by the EPO, JPO, or USPTO, copies of the documents cited in the international search report are made available to the examiner in the national stage application.

**When all the requirements for a national stage application have been completed, applicant is notified (Form PCT/DO/EO/903) of the acceptance of the application under 35 U.S.C. 371, including an itemized list of the items received. The itemized list includes an indication of whether a copy of the international search report and copies of the references cited therein are present in the national stage file. The examiner WILL consider the documents cited in the international search report, without any further action by applicant under 37 CFR 1.97 and 1.98, when both the international search report and copies of the documents are indicated to be present in the national stage file. The examiner will note the consideration in the first Office action. There is no requirement that the examiners list the documents on a PTO-892 form. See form paragraphs 6.53, 6.54, and 6.55 (reproduced in MPEP § 609). Otherwise, applicant must follow the procedure set forth in 37 CFR 1.97 and 1.98 in order to ensure that the examiner considers the documents cited in the international search report.**

This practice applies only to documents cited in the international search report relative to a national stage application filed under 35 U.S.C. 371. It does not apply to documents cited in an international preliminary examination report that are not cited in the search report. It does not apply to applications filed under 35 U.S.C. 111(a) claiming the benefit of an international application filing date. (Emphasis added).

Applicants respectfully submit that the enclosed Notification of Acceptance of Application Under 35 U.S.C. 371 and 37 C.F.R. 1.494 and 1.495 (hereinafter "FORM PCT/DO/EO/903") was mailed from the U.S. Patent and Trademark Office on June 15, 2001. The FORM PCT/DO/EO/903 indicates in Paragraph No. 4 (the fifteenth box down) that a copy of the International Search Report and copies of the references cited therein were received by the U.S. Patent and Trademark Office. Thus, according to MPEP § 1893.03(g), "the Examiner will consider the documents cited in the international search report, without any further action by applicant under 37 CFR 1.97 and 1.98, when both the international search report and copies of the documents are indicated to be present in the national stage file. Thus, Applicants respectfully submit that they have not failed to comply with 37 C.F.R.

§ 1.98(a)(3) and respectfully request that the Examiner consider the Information Disclosure Statement filed on August 9, 2001.

The specification has been amended to change the title of the invention from “MASSAGING APPARATUS” to --MASSAGING APPARATUS HAVING PIVOTALLY SUPPORTED SUPPORTING ARM WITH THERAPEUTIC MEMBER--. Applicants respectfully submit that the amendment to the specification does not add new matter. Based on the foregoing, Applicants respectfully request withdrawal of the objection to the title of the invention as not being descriptive.

Applicants respectfully traverse the rejection of claims 39, 42, 48, and 49 under 35 U.S.C. § 112, second paragraph, as being indefinite. More particularly, the Office Action alleges that independent claims 39 and 42 are indefinite because the phrase “wherein a position of a specific portion of the user with respect to the massaging apparatus is determined from a relation between a vertical position of the supporting arm and a pivotal position of the supporting arm” is unclear as to how and by what structural element is being used to determine the recited relation.

Applicants respectfully submit that it is clear that the supporting arm always has a vertical position as well as a pivotal position (i.e., A7) along which a portion of the body (i.e., shoulder) of the user is established. Since it is clear from the recited wherein clause that the position of a part of the body of the user of the massaging apparatus can be determined with respect to the massaging apparatus by knowledge of the vertical position and the pivotal position of the supporting arm, Applicants respectfully submit that the recited wherein clause is not unclear or indefinite.

Nevertheless, independent claims 39-42 and dependent claims 43 and 48-51 have been amended for clarity. More particularly, independent claims 39-42 have been amended

to make it clear that the supporting arm has a therapeutic member, the supporting arm is pivotally supported on the massaging apparatus, and the supporting arm is movable along a body of a user of the massaging apparatus.

With respect to the rejection of claims 39-42 and 48-51 under 35 U.S.C. § 102(e) as being anticipated by *Canto*, Applicants respectfully submit that they are hereby perfecting their claim of priority by submitting the enclosed certified translations of the priority documents, namely, Japanese Patent Application No. 11/255930 (hereinafter “JP ‘930”), filed on September 9, 1999 in the Japanese Patent Office, Japanese Patent Application No. 11/304069 (hereinafter “JP ‘069”), filed on October 26, 1999 in the Japanese Patent Office, Japanese Patent Application No. 11/304070 (hereinafter “JP ‘070”), filed on October 26, 1999 in the Japanese Patent Office, Japanese Patent Application No. 2000/8358 (hereinafter “JP ‘358”), filed on January 17, 2000 in the Japanese Patent Office, Japanese Patent Application No. 2000/56185 (hereinafter “JP ‘185”), filed on March 1, 2000 in the Japanese Patent Office, and Japanese Patent Application No. 2000/163289 (hereinafter “JP ‘289”), filed on May 31, 2000 in the Japanese Patent Office. Applicants respectfully submit that since original claims 39-43 and 48-51 are fully supported by the subject matter contained in JP ‘930, JP ‘069, JP ‘070, JP ‘358, JP ‘185, and JP ‘289, they have now perfected their claim to priority by providing the certified translations of those priority documents and therefore, now have a 35 U.S.C. § 102(e) date back to September 9, 1999 which is prior to *Canto*’s effective U.S. filing date of May 3, 2000 (i.e., its § 371 (c)(1), (2), and (4) date). Based on the foregoing, Applicants respectfully submit that the rejection of claims 39-42 and 48-51 under 35 U.S.C. § 102(e) as being anticipated by *Canto* and the rejection of claim 43 under 35 U.S.C. § 103(a) as being unpatentable over *Canto* in view of *Imazaike et al.* has now been overcome.

Applicants respectfully submit that the amendments to claims 39-43 and 48-51 do not add new matter. Applicants also respectfully submit that amended claim 48 is directly dependent upon amended claim 39 so that arguments serving to patentably distinguish amended claim 39 from the prior art of record are available, among others, to patentably distinguish amended claim 48. Applicants also respectfully submit that amended claims 43 and 50 are directly dependent upon amended claim 40 so that arguments serving to patentably distinguish amended claim 40 from the prior art of record are available, among others, to patentably distinguish amended claims 43 and 50. Applicants also respectfully submit that amended claim 51 is directly dependent upon amended claim 41 so that arguments serving to patentably distinguish amended claim 41 from the prior art of record are available, among others, to patentably distinguish amended claim 51. Applicants also respectfully submit that amended claim 49 is directly dependent upon amended claim 42 so that arguments serving to patentably distinguish amended claim 42 from the prior art of record are available, among others, to patentably distinguish amended claim 49.

Based on the foregoing, Applicants respectfully request withdrawal of the rejection of claims 39, 42, 48, and 49 under U.S.C. § 112, second paragraph, as being indefinite, withdrawal of the rejection of claims 39-42 and 48-51 under 35 U.S.C. § 102(e) as being anticipated by *Canto*, withdrawal of the rejection of claim 43 under 35 U.S.C. § 103(a) as being unpatentable over *Canto* in view of *Imazaike et al.*, and allowance of claims 39-43 and 48-51.

In view of the foregoing, claims 39-43 and 48-51 are believed to be in condition for allowance, and an early and favorable action to that effect is respectfully requested.

Respectfully submitted,

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**IN THE SPECIFICATION:**

Please amend the specification, as follows:

Page 1, line 2, please replace the title of the invention, with the following:

**MASSAGING APPARATUS HAVING PIVOTALLY  
SUPPORTED SUPPORTING ARM WITH THERAPEUTIC MEMBER**

**IN THE CLAIMS:**

Please amend claims 39-43 and 48-51, as follows:

39. (Amended) A massaging apparatus comprising:

a supporting arm having a therapeutic member, the supporting arm being pivotally supported [thereon] on the massaging apparatus and the supporting arm being movable along a body of a user, wherein (a position of a specific portion of the body of the user with respect to the massaging apparatus is determined from a relation between a vertical position of the supporting arm and a pivotal position of the supporting arm.)

40. (Amended) A massaging apparatus comprising:

a supporting arm having a therapeutic member, the supporting arm being pivotally supported [thereon] on the massaging apparatus and the supporting arm being movable along a body of a user[,]; and

a pivotal-position-detecting sensor for detecting that the supporting arm has reached a prescribed range of pivotal movement.

41. (Amended) A massaging apparatus comprising:

a supporting arm having a therapeutic member, the supporting arm being pivotally supported [thereon] on the massaging apparatus and the supporting arm being movable along a body of a user[,]; and

a pivotal-position-detecting sensor for detecting [the] a pivotal position of the supporting arm.

42. (Amended) A massaging apparatus comprising:

a supporting arm having a therapeutic member, the supporting arm being pivotally supported [thereon] on the massaging apparatus and the supporting arm being movable along a body of a user, wherein a position of a specific portion of the user with respect to the massaging apparatus is determined from a vertical position of the supporting arm at a moment when [the] a pivotal position of the supporting arm has reached a prescribed range.

43. (Amended) [A] The massaging apparatus as set forth in [Claim] claim 40, wherein the pivotal-position-detecting sensor comprises an optical sensor having a light emitting element and a light receiving element, and [the fact that] whether or not the supporting arm has reached the prescribed range of pivotal movement is detected by determining [whether or not] if light from the light emitting element [is] has been received by the light receiving element.

48. (Amended) [A] The massaging apparatus as set forth in [Claim] claim 39, wherein the position of the specific portion of the body of the user to be determined is [the] a position of [the] a shoulder of the body of the user.

49. (Amended) [A] The massaging apparatus as set forth in [Claim] claim 42, wherein the position of the specific portion of the body of the user to be determined is [the] a position of [the] a shoulder of the body of the user.

50. (Amended) [A] The massaging apparatus as set forth in [Claim] claim 40, [wherein there are provided] further comprising a second supporting arm and a second pivotal-position-detecting sensor, wherein the supporting arm and the second supporting arm constitute a pair of left and right supporting arms, and [a pair of pivotal-position-detecting sensors corresponding to the respective] wherein the pivotal-position-detecting sensor is associated with the supporting arm and the second pivotal-position-detecting sensor is associated with the second supporting [arms] arm.

51. (Amended) [A] The massaging apparatus as set forth in [Claim] claim 41, [wherein there are provided] further comprising a second supporting arm and a second pivotal-position-detecting sensor, wherein the supporting arm and the second supporting arm constitute a pair of left and right supporting arms, and [a pair of pivotal-position-detecting sensors corresponding to the respective] wherein the pivotal-position-detecting sensor is associated with the supporting arm and the second pivotal-position-detecting sensor is associated with the second supporting [arms] arm.